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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,510	06/21/1999	KOICHI ABE	1232-4544	5401

7590 12/03/2003

MORGAN & FINNEGAN L L P
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 12/03/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/334,510

Applicant(s)

ABE, KOICHI

Examiner

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-17, 19, 20 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-17, 19-20 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. Applicant's arguments filed August 18 2003 have been fully considered but they are not persuasive.
2. Applicant argues that the print device includes the detector configured to detect print or scan the original, examiner believes that the scanner and sensors could be attached as shown in Fig.9 to the printer and therefore included in the printing device.
- 3.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-17,19-20 and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oida et al (U.S. patent 5,634,187) in view of Cotte et al (U.S. patent 5,499,108)

Regarding claims 5, 11,19 ,20 ,22 and 23 Oida et al disclose: A scanning system comprising: a print device with a scanner function (please note Fig.2 item 219 (printer/scanner unit, column 3 lines 58-65 where Oida et al teach the combination of the computer200 and printer/ scanner 219) which allows printing and scanning by selectively mounting a print head and scan head on a head mounting portion (please note Fig.2 column 4 lines 33-37 where Oida et al teach the mounting of both print head

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and scan head selectively) and an external computer which is connected to said print device to be able to communicate therewith (please note Fig.2 column 4 lines 33-34 where the computer is connected to the printer/scanner device) and comprises a scanner software for controlling scanning operation of said print device (please note column 4 lines 38-42 where the printer and scanner are communicating with the host device through the I/Q ports to exchange status data and print/scan data)

Oida et al does not disclose:

wherein said print device includes a detector configured to detect selectively a print sheet in the printing and an original to be scanned in the scanning wherein in a case said scan head is mounted on said head mounting portion and said detector detects the original to be scanned in the scanning said print device communicates with said external computer to execute the scanning by said scanner software

On the other hand Cotte et al disclose:

wherein said print device includes a detector configured to detect selectively a print sheet in the printing and an original to be scanned in the scanning (please note Cotte et al Fig.9 items 86 which could be attached to the scanner which includes the detector as one printing system, column 7 lines 65-67 and column 8 lines 1-7)

wherein in a case said scan head is mounted on said head mounting portion and said detector detects the original to be scanned in the scanning said print device communicates with said external computer to execute the scanning by said scanner software (please note Cotte et al Fig.12 column 10 lines 19-40 and specifically lines 34-

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34-38 where the sensor is setting off to notify the host as soon as the paper is put on the scanner to be scanned also please note column 10 lines 59-64).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Oida et al's invention according to the teaching of Cotte et al, Cotte et al in the same field of endeavor teach the way that the scanner could be attached to the printer to be able to detect and sense the paper by using the sensors included in.

Regarding claims 6,12 and 26 Oida et al disclose: The system according to claim 1, wherein said print device is designed to send a scanner start signal to said external computer when said scan head is mounted on said head mounting portion (please note Fig.8 column 6 lines 8-16 where the signal to and from the scan head was sent to the host) said scanner software comprises a detection module for detecting the scanner start signal said detection module alone in said scanner software is running in a standby state in which said printer device has not been started as a scanner (please note column 4 lines 33 to 38 where the scanner or printer is mounted selectively as computer performs printing or scanning respectively) and modules other than said detection module in said scanner software are started when said detection module detects the scanner start signal (please note Fig.2 lines 39-42 where printer/scanner is connected to the computer through a parallel interface therefore communicating bi-directionally).

Regarding claims 7 and 13 Oida et al disclose: The system according to claim 6, wherein when all the modules in said scanner software are running, said detection

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module uses a sufficiently small work area of said external computer compared to other modules (please note column 5 lines 57-61).

Regarding claims 8,14 and 27 Oida et al disclose: the system according to claim 1, wherein said print head is an ink-jet print head (please note Fig.1 column 3 lines 60-63).

Regarding claims 9 and 15 Oida et al disclose: The system according to claim 5, further comprising prescan selection means for selecting whether or not a prescan is made upon scanning the original (please note Fig.2 column 4 lines 1-14) and wherein when said scanner software is started and it is selected by said prescan selection means that the prescan is to be made, an image of the original is prescanned and read into said scanner software (please note column 5 lines 46-67).

Regarding claims 10 and 16 Oida et al disclose: The system according to claim 9, wherein said scanner software displays the prescanned and read image (please note column 4 lines 8-10 where the image is displayed before scanning).

Regarding claim 17 Oida et al disclose: The system according to claim 11, wherein said scanner software comprises application software run detection means for detecting whether or not said application software is running (please note column 4 lines 27-33).

Regarding claims 24 and 28-29 Oida et al disclose: A method of controlling a scanning system, which comprises a print device with a scanner function, which allows printing and scanning by selectively mounting a print head and scan head on a head mounting portion (please note column 4 lines 33-39) and an external computer which is

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connected to said print device to be able to communicate therewith (please note column 4 lines 38-42)

Oida et al do not disclose: and comprises a scanner software which can control scanning of said print device, comprising the step of: Controlling said print device to communicate with said external computer so as to start said scanner software and to read an image of the original into said scanner software when said scan head is mounted on said head mounting portion and an original is set on said print device.

On the other hand Cotte et al disclose: and comprises a scanner software which can control scanning of said print device, comprising the step of: Controlling said print device to communicate with said external computer so as to start said scanner software and to read an image of the original into said scanner software when said scan head is mounted on said head mounting portion and an original is set on said print device.

(Please note Fig.12 column 10 lines 19-62 where Cotte et al teach the sensor which is being sent from the scanner when the paper for scanning is applied to the host to start the software for scanning).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Oida et al's invention according to the teaching of Cotte et al where Cotte et al in the same field of endeavor teaches the way which the paper could be set up in the scanner as to indicate to the host of its readiness to start the software in the host for scanning.

Regarding claim 25 Oida et al disclose; The system according to claim 24, wherein said print device is designed to send a scanner start signal to said external

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computer when said scan head is mounted on said head mounting portion said scanner software comprises a detection module for detecting the scanner start signal, said detection module alone in said scanner software is running in a standby state in which said printer device has not been started as a scanner, and modules other than said detection module in said scanner software are started when said detection module detects the scanner start signal (please note column 2 lines 54-67 and column 3 lines 1-6).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Other prior art cited

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Oida et al (U.S. patent 5,987,186) is pertinent as disclosing an image processing, apparatus and system having detachably mounted read cartridge.

Katayama et al (U.S. patent 5,842,793) is pertinent as disclosing a printing device.

Lee (U.S. patent 6,155,665) is pertinent as disclosing a position compensating technique used during two-way printing and scanning.

Yoshida (U.S. Patent 6,334,665) is pertinent as disclosing a printing system and method of printing.

Lee (U.S. patent 6,236,471) is pertinent as disclosing a vertical alignment correction apparatus and method.

Cotte et al (U.S. patent 5,499,108) is pertinent as disclosing a document-driven scanning input device communicating with a computer.

Contact Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles, can be reached at (703) 305-4712.

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Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(703) 872-9314, or (703) 308-9052 (for **formal** communications; please
mark
"EXPEDITED PROCEDURE")

Or:

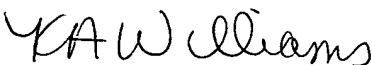
(703) 306-5406 (for **informal** or **draft** communications, please label
"PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA. Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be
directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy
Patent Examiner
Group Art Unit 2622
November 25 2003




KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER